

OCT 19 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Sterling Mortensen Examiner: Dohm Chankong
Serial No.: 09/941,467 Group Art Unit: 2152
Filed: August 29, 2001 Docket No.: 10004428-1
Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

CERTIFICATE OF TRANSMISSION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the following papers are being facsimile transmitted to the U.S.
Patent and Trademark Office, Fax No.: (571) 273-8300 on the date shown below:

1. Transmittal Letter for Reply Brief (1 pg.); and
2. Reply Brief to Examiner's Answer (5 pgs.)

Respectfully submitted,

Sterling Mortensen,

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Date: OCT. 19, 2006
SAL:hsf

By: 

Scott A. Lund
Reg. No. 41/166

7 PAGES – INCLUDING COVER PAGE

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HEWLETT-PACKARD COMPANY
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P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10004428-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICEInventor(s): Sterling Mortensen
Application No.: 09/941,467
Filing Date: August 29, 2001Confirmation No.: 6476
Examiner: Dohm Chankong
Group Art Unit: 2152

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF REPLY BRIEFTransmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on August 22, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

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By 

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Rev 10/05 (Reply Brief)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|-------------|--|-----------------|---------------|
| Appellant: | Sterling Mortensen | Examiner: | Dohm Chankong |
| Serial No.: | 09/941,467 | Group Art Unit: | 2152 |
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REPLY BRIEF TO EXAMINER'S ANSWER

Mail Stop Appeal Brief – Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir/Madam:

This Reply Brief is presented in response to the Examiner's Answer mailed August 22, 2006, and in support of the Notice of Appeal filed May 1, 2006 and the Appeal Brief filed June 6, 2006, appealing the rejection of claims 1-4, 9, 10, 12-20, 25, and 27-30 of the above-identified application as set forth in the Final Office Action mailed March 9, 2006.

At any time during the pendency of this application, please charge any fees required or credit any overpayment due to Deposit Account No. 08-2025 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees required to Deposit Account No. 08-2025 under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Appellant respectfully requests reconsideration and reversal of the Examiner's rejection of pending claims 1-4, 9, 10, 12-20, 25, and 27-30.

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Reply Brief to Examiner's Answer

Appellant: Sterling Mortensen

Serial No.: 09/941,467

Filed: August 29, 2001

Docket No.: 10004428-

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE**ARGUMENT****Reply to Examiner's Response to Argument**

As outlined in the Appeal Brief at pages 5-6, independent claims 1 and 17 each include "translating the data file of the electronic document into print instructions for the electronic document, transferring the print instructions to a printer, and converting the print instructions into the translated data file for the electronic document at the printer."

As outlined in the Appeal Brief at page 6, independent claim 18 includes "a first processor adapted to translate a data file of the electronic document into print instructions for the electronic document and a second processor adapted to convert the print instructions into a translated data file for the electronic document, wherein the first processor is part of a computer and the second processor is part of a printer."

The Examiner contends that "[i]n the context of Santamaki's invention, printing an electronic document means translating the electronic document into print instructions..., transferring the print instructions to a printer (Santamaki's e-book server emulating a printer)...and converting the received instructions into a data file for the electronic document at the printer..." Examiner's Answer, pages 8-9 (emphasis added). Thus, the Examiner concludes that "Santamaki's e-book server represents a printer within the context of Santamaki's invention," and that "Santamaki's e-book server is analogous to Applicant's claimed printer" Examiner's Answer, page 9 (emphasis added). By contending that Santamaki's e-book server "emulat[es] a printer," "represents a printer," and "is analogous to Applicant's claimed printer," the Examiner implicitly recognizes that the system of the Santamaki et al. patent does not include a printer.

Once again, Appellant notes that to anticipate a claim under 35 U.S.C. 102, a reference must teach every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference").

The Santamaki et al. patent discloses an electronic book system including a computer system (desktop PC) 10, a centralized server 12 having a database 14, a private network 20, an e-book server 30, an electronic book (e-book) terminal 50, and a public network 50 (Fig.

Reply Brief to Examiner's Answer

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Docket No.: 10004428-

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1; col. 5, lines 6-19). As such, as outlined in the Appeal Brief at page 6, the Santamaki et al. patent discloses an electronic book system in which the electronic document is converted into an e-book format "at the desktop PC 10" if the emulation software is installed at the desktop PC 10 and, alternatively, an electronic book system in which the electronic document is converted into an e-book format "at the e-book server 30" if the emulation software is installed at the e-book server 30 (col. 7, lines 21-32; col. 8, lines 7-16). Thus, as outlined in the Appeal Brief at page 6, with the system of the Santamaki et al. patent, the electronic document is converted into an e-book format at the desktop PC 10 or at the e-book server 30. The Santamaki et al. patent, however, does not disclose the electronic document being converted at a printer.

Furthermore, the Santamaki et al. patent does not disclose translating a data file of an electronic document into print instructions for the electronic document, and does not disclose transferring the print instructions to a printer whereat the print instructions are converted into a translated data file for the electronic document. For example, the Santamaki et al. patent simply discloses that "[t]he selected electronic document from the desktop PC 10 may be directed or transferred to the designated e-book server 30..." (col. 6, lines 58-60), and discloses that "the emulation software converts data reflecting the electronic document into an e-book format and reformats the data for a remote e-book terminal" (col. 7, lines 62-65). The system of the Santamaki et al. patent, however, does not translate a data file of an electronic document into print instructions for the electronic document, and does not transfer the print instructions to a printer whereat the print instructions are converted into a translated data file for the electronic document.

The Santamaki et al. patent, therefore, does not disclose translating a data file of the electronic document into print instructions for the electronic document, does not disclose transferring the print instructions to a printer, and does not disclose converting the print instructions into a translated data file for the electronic document at the printer.

Thus, for the reasons set forth above, as well as the reasons set forth in the Appeal Brief filed June 6, 2006, Appellant submits that the Santamaki et al. patent does not teach or suggest each and every element of independent claims 1, 17, and 18. Accordingly, Appellant submits that independent claims 1, 17, and 18 are each patentably distinct from the Santamaki et al. patent. Furthermore, as dependent claims 2-4, 9-10, and 12-16 further define patentably

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distinct claim 1, and dependent claims 19-20, 25, and 27-30 further define patentably distinct claim 18, Appellant submits that these dependent claims are also patentably distinct from the Santamaki et al. patent. Appellant, therefore, respectfully submits that the rejection of claims 1-4, 9, 10, 12-20, 25, and 27-30 under 35 U.S.C. 102(e) is not correct and should be withdrawn, and that claims 1-4, 9, 10, 12-20, 25, and 27-30 should be allowed.

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CONCLUSION

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

Any inquiry regarding this Reply Brief should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

IP Administration
Legal Department, M/S 35
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Respectfully submitted,

Sterling Mortensen,

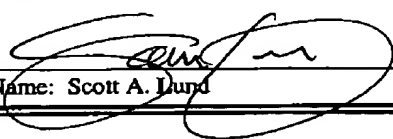
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 19TH day of October, 2006.

By 
Name: Scott A. Lund